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10/774,454	02/10/2004	Takao Saito	811_106	9153
25191	7590	04/12/2010	EXAMINER	
BURR & BROWN			TUROC, DAVID P	
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SYRACUSE, NY 13261-7068			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/774,454

Applicant(s)

SAITO ET AL.

Examiner

DAVID TUROCY

Art Unit

1715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/1/2010 has been entered.

Response to Amendment

2. Applicant's amendments filed 4/1/2010, have been fully considered and reviewed by the examiner. The examiner notes the amendment to claims 1 and 8 and the cancellation of claim 12-13. Claims 1-3, 5, 7-8, and 10-11 remain pending with claims 5 and 7 withdrawn due to a restriction requirement.

3. The declaration under 37 CFR 1.132 filed 4/1/2010 is insufficient to overcome the rejection of claims based upon Yara as set forth in the last Office action because: the facts presented are not germane to the rejection at issues. The use of nitrogen and glass on both electrodes are not germane to the issues because Yara discloses the electrodes are not both coated and discloses using He as the dilution gas. Additionally, the showing of facts relating to the present invention are not commensurate in scope with the claims because they include many requirements and narrower requirements that are not present in the claims.

Response to Arguments

4. Applicants provided support for "not crystalline diamond like carbon" is not sufficient because the negative limitation necessarily results in inclusion of all other types of diamond like carbon that were not explicitly discloses in the application. Negative limitations recited to overcome prior art can be considered new matter. *Ex Parte Grasselli et al. 231 USPQ 393*. Additionally, the mere absence of a positive recitation in the original specification is not basis for the exclusion of a feature. *Ex Parte Grasselli 231 USPQ 393,394*. (Bd. App. 1983). There is no supporting evidence that the disclosure is for non-crystalline diamond like carbon and even the declaration discloses the deposited film is amorphous (see paragraph 6) but does not discloses that is represents ALL non-crystalline types of films as now presently claimed.

Applicant's provided support for "opposing electrodes not covered with a solid dielectric material" is not sufficient because by specifically excluding a dielectric coating the claims necessarily incorporate all other types of coatings. These other types of coatings are not disclosed by the applicant in any sense and the mere teaching of electrodes that are not coated does not provide the support for only excluding dielectric material. By excluding one type of coating material, the claims necessarily result in the inclusion of all other types of coatings that are neither taught or suggested and it is this that results in the new matter. The figures themselves can support no coating on the electrodes, but does not support the claims as drafted.

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5. Applicant's arguments filed 4/1/2010 have been fully considered but they are not persuasive because they are directed at newly added claim limitations and therefore the arguments are deemed moot.

As for the requirement of the atmosphere consisting of carbon source gas and dilution gas, the examiner notes this is explicitly taught by Yara, where Yara discloses either supplying a dilution gas with a carbon source gas or a carbon source gas and oxygen and/or hydrogen. Yara explicitly discloses He can be used as the dilution gas (0041) and therefore selection of this would have been obvious to provide predictable results.

As for the requirement of impulse voltage, this is taught by Yara as admitted by applications remarks page 5.

As for the requirement of opposing electrodes are not covered with a solid dielectric, the examiner notes the teachings of a single electrode coated of two electrode as taught by Yara clearly does not read on the requirement that opposing electrodes are not covered. Specifically the electrodes are not covered by dielectric in Yara, but rather a single of the electrodes is covered.

Yara discloses the temperature as claimed (0051) in claims 10-11.

Added Claim limitations, Yara discloses including gases from the VIII group of the periodic table (0041), discloses impulse voltage and a single electrode is not covered with a solid dielectric material (i.e. the opposing electrodes are not both covered, which meets the limitations of the claims as written)

As for the requirement of the DLC that is not crystalline DLC, the examiner notes the prior art discloses the same gases, same pressure, substantially the same process parameters (i.e. 999 ns vs 1000 ns) and therefore it remains the examiners position that the film deposited by Yara will have substantially the same properties unless the applicant is performing properties that are not specifically claimed. Additionally, since the process parameters are substantially the same, the examiner notes that the film as deposited by Yara will have a portion of the film with the properties as claimed.

The applicant's have narrowly constructed the teachings of Yara. The mere presence of a single example does not foreclose the entire teachings of the reference. The reference broadly discloses a technique for depositing a DLC layer and discloses one example that deposits a DLC layer that has the characteristics as disclosed in the example. The example discloses deposition of a DLC layer, the overall objective of the Yara reference (see title "production of diamond-like thin carbon film" and the Raman spectrum is used to show the DLC layer is in fact formed. The prior art does not limit their deposited films to only those that result in a peak of 1333 cm^{-1} , but rather includes one example. The prior art discloses the same process gases, the same dilution gases, and same plasma pulsing using an impulse voltage and opposing electrodes that are not coated with dielectric material and therefore the deposited film must be considered to have the same properties as claimed, unless the applicant is performing process steps that are not being claimed. The mere observation of still another beneficial result of an old process cannot form the basis of patentability. Allen et al. v. Coe, 57 USPQ 136; In re Maeder et al. 143 USPQ 249.

The applicant's arguments with respect to the secondary references or Hartmann and Awazu are unpersuasive because they fail to address the teachings in regards to the combination of references. Additionally, Hartmann discloses the DLC Raman spectrum is adjusted by varying the gas phase concentrations (page 854). Additionally, Awazu discloses DLC films deposited have a broad peak around 1590 cm^{-1} and a peak around 1360 cm^{-1} (page 173). Additionally, Awazu, at figure 3 and 4, discloses such Raman spectrum for a deposited DLC film using a plasma includes the peaks as claimed by the applicant and discloses adjusting the gas flows to achieve the desired Raman spectrum (175).

All other applicants' arguments not specifically addressed above are unsupported by any factual evidence and thus are deemed mere attorney speculation and thus are deemed moot. It is well settled that arguments of counsel unsupported by competent factual evidence of record are entitled to little weight. *In re Payne*, 606 F.2d 303,315, 203 USPQ 245,256 (CCPA 1979).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-3, 8, 10-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-3, 8, 10-11 include the limitations that the deposited film "that is not crystalline diamond like carbon", however, the examiner can not locate support for this limitation in the original disclosure. The examiner notes the negative limitation is not explicitly or implicitly disclosed by the original disclosure and therefore is deemed new matter. Negative limitations recited to overcome prior art can be considered new matter. *Ex Parte Grasselli et al. 231 USPQ 393*. Additionally, the mere absence of a positive recitation in the original specification is not basis for the exclusion of a feature. *Ex Parte Grasselli 231 USPQ 393,394*. (Bd. App. 1983).

Claims 1-3, 8, 10-13 includes the limitation "said opposing electrodes are not covered with a solid dielectric material"; however again the negative limitations recited to overcome prior art can be considered new matter. *Ex Parte Grasselli et al. 231 USPQ 393*.

If the applicant can provide support for the claim limitations the examiner will withdraw the prior rejections.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-12735 by Yara et al, hereinafter Yara alone or further in view of "Deposition of thick diamond films by pulsed d.c. glow discharge CVD" By Hartmann et al. or "DLC films formed by hybrid pulse plasma coating (HPPC) System" by Awazu et al.

The examiner incorporates by reference the discussion in paragraph 4 above.

Claim 1: Yara discloses a method of producing a thin film using opposing electrodes by applying a pulse voltage to opposing electrodes under a pressure within the claimed range and under an atmosphere comprising a gaseous raw material including a carbon source to generate discharge plasma so that a thin film is formed on a substrate. (see for example abstract, paragraphs 0008-0013, figures). The pulse has a duration 1000 nanoseconds (0011). A *prima facie* case of obviousness exists where the claimed ranges and prior art do not overlap but are close enough that one in ordinary skill in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 f.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05. Specifically, one of ordinary skill in the art would deem 1000 nanoseconds to have similar properties to that with a 999 nanosecond pulse duration.

As for the requirement of Raman spectrum. The examiner notes the film deposited by Yara is diamond like carbon (0013), and the process as taught by Yara disclose the pulsed plasma deposition and the prior art and the present claims, reflected by claim 1, teach all the same process steps and thus the results obtained by applicants process must necessarily be the same as those obtained by the prior art. Therefore by

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pulsed plasma process, it must necessarily result in the claimed Raman spectrum.

Either 1) the applicant and the prior art have different definitions for DLC films, or 2) the applicant is using other process steps or parameters that are not shown in the claims. Specifically, it is the examiners position that a DLC film deposited at 999 ns pulses will necessarily have the same Raman spectrum as that deposited at 1000 ns.

Yara discloses depositing a DLC coating layer by pulse deposition and discloses a Raman spectrum peak at 1332 cm^{-1} , however, fails to explicitly disclose a broad peak at about 1580 cm^{-1} and a shoulder peak between 1300-1500 as required by the claim. However, Hartmann and Awazu disclose the Raman spectrum of deposited films. Hartmann discloses a DLC films are measured using Raman spectrum, including a diamond peak at 1332 cm^{-1} and a broader peak at 1550 cm^{-1} (which can be considered about 1580 cm^{-1} as required by the claim) (Figure 4 (d), page 854). Additionally, Hartmann discloses the DLC Raman spectrum is adjusted by varying the gas phase concentrations (page 854). Additionally, Awazu discloses DLC films deposited have a broad peak around 1590 cm^{-1} and a peak around 1360 cm^{-1} (page 173). Additionally, Awazu, at figure 3 and 4, discloses such Raman spectrum for a deposited DLC film using a plasma includes the peaks as claimed by the applicant and discloses adjusting the gas flows to achieve the desired Raman spectrum (175).

Therefore, the evidence suggests that the process of Yang, which deposits a DLC layer, must have a similar Raman spectrum as taught by Hartman and Awazu as associated with DLC deposited layers, that is a diamond peak at 1332 cm^{-1} (that

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addressed in the disclosure of Yara) accompanied by a broader peak at 1550 cm^{-1} or 1590 cm^{-1} (which can be considered about 1580 cm^{-1} as required by the claim).

At the very least, Harmann and Awazu disclose known and suitable Raman spectrums for deposited DLC layers and both disclose adjusting the ratio of the gases to deposit the DLC with the desired Raman Spectrum. Therefore, taking the references collectively, it would have been obvious to one of ordinary skill in the art to have adjusted the process parameters in the process of Yang to achieve the predictable and desired Raman spectrum. A predictable use of prior art elements according to their established functions to achieve a predictable result is prima facie obvious. See *KSR Int'l Inc. v. Teleflex Inc.*, 127 S Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

Added Claim limitations, Yara discloses including gases from the VIII group of the periodic table (0041) and He, discloses impulse voltage and a single electrode is not covered with a solid dielectric material (i.e. the opposing electrodes are not both covered, which meets the limitations of the claims as written)

As for the requirement of the DLC that is not crystalline DLC, the examiner notes the prior art discloses the same gases, same pressure, substantially the same process parameters (i.e. 999 ns vs 1000 ns) and therefore it remains the examiners position that the film deposited by Yara will have substantially the same properties unless the applicant is performing properties that are not specifically claimed. Additionally, since the process parameters are substantially the same, the examiner notes that the film as deposited by Yara will have a portion of the film with the properties as claimed.

Claim 2. The pulse voltage of Yara has a pulse rise time of 1000 nsec or shorter (0010).

Claim 3. The pulse voltage of Yara has a pulse fall time of 1000 nsec or shorter (0010).

Claim 10: Yara discloses the substrate temperature (0051).

10. Claims 1-3 and 8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-12735 by Yara et al, hereinafter Yara and further in view of "Characterization of Ultra-Short pulsed Discharge Plasma for CVD processing" by Mizuno, hereafter Mizuno.

The examiner incorporates by reference the discussion in paragraph 4 above.

Yara is applied here for the all the same reasons as set forth above and the examiner maintains the position as set forth above. However, Mizuno discloses that in order to achieve an active control of plasma using pulse duration of less than 1 ms (1000 ns). Mizuno discloses that such active control of the plasma structure in space and time allows for optimum reaction filed and controlling the ions and radicals life time. (page 656). Mizuno discloses using a high voltage in combination with pulses of 50-1000 ns duration without any plasma non-uniformity or arcing because voltage amplitude falls to zero before glow to arc transition (abstract).

Therefore, taking the references collectively, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Yara by providing high voltage pulses of 50 - 1000 ns as suggested by Mizuno to reap the benefits of

providing active control. Please note that the test of obviousness is not an express suggestion of the claimed invention in any or all references, but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them (*In re Rosselet*, 146 USPQ 183).

Additionally, the claim would have been obvious because the technique for improving particular methods was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations. See *KSR Int'l Inc. v. Teleflex Inc.*, 127 S Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

As for the requirement of Raman spectrum. The examiner notes the film deposited by Yara is diamond like carbon (0013), and the process as taught by Yara in view of Mizuno disclose the pulsed plasma deposition with pulses in the range as claimed. Therefore, since the prior art and the present claims, reflected by claim 1, teach all the same process steps, the results obtained by applicants process must necessarily be the same as those obtained by the prior art. Therefore by pulsed plasma process, it must necessarily result in the claimed Raman spectrum. Either 1) the applicant and the prior art have different definitions for DLC films, or 2) the applicant is using other process steps or parameters that are not shown in the claims.

Claims 10-11: Yara discloses these claims as discussed above.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571)272-2940. The examiner can normally be reached on Tuesday, Thursday, and Friday from 7 a.m. - 6 p.m., Monday and Wednesday 5-8 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Turocy/
Primary Examiner, Art Unit 1715

